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EXAMINER

ABRISHAMKAR, KAVEH

ART UNIT PAPER NUMBER

2131

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/035,814

Applicant(s)

SCOTT, RANDAL

Examiner

Kaveh Abrishamkar

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47, 55, 56, 59-67, 70, 72, 92, 94 and 97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47, 55-56, 59-67, 70, 72, 97-92 and 94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed on July 18, 2005. Claims 1-94 were originally received for consideration. Per the received amendment, claims 1-47, 55-56, 59-67, 70, 72, 97-92 and 94 are currently being considered.

Response to Arguments

2. Applicant's arguments filed July 18, 2005 have been fully considered but they are not persuasive because:

Regarding amended independent claim 1, the applicant argues that the CPA, Holden, Huff, Weschler, and Eberhardt do not teach the newly added limitation of "members interested in avoiding or treating a particular medical condition." This argument is not found persuasive. Holden discloses "the patient has control to voluntarily allow access to particular people" (column 1 lines 65-67), and further discloses that a medical practitioner "can run tests based on the profile" (column 1 lines 50-53) It is believed that these cited passages teach a group (the patient, the medical practitioner and others allowed access by the patient), and that the members are interested in treated or avoiding a particular medical condition based on the tests that are performed. Furthermore, applicant argues that the CPA does not teach "providing the participant with access to group functions and information" as recited in claim 63.

Art Unit: 2131

This argument is not found persuasive. Holden teaches that “the patient has control to voluntarily allow access to particular people and for particular purposes” (column 1 lines 65-66), and that tests can be run and the results supplied using the profile data. This is asserted to teach the limitation “providing the participant with access to group functions and information.” In light of the amendments, a new rejection is given below using the same CPA of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 6, 7, 9, 10, 14-18, 27, 33, 35-39, 41, and 94 are rejected under 35 U.S.C. 102(e) as being anticipated by Holden (U.S. Patent 6,640,211).

5. With respect to claim 1, Holden discloses a genomic profile information system accessible over a communications network (column 2, lines 39-44), the genomic profile information system comprising:

Data for a plurality of participants indicating genomic profile information of the .
participants (column 1, lines 56-57); and

A software system comprising privacy settings for at least one of the participants
and controlling access by others over the communications network to genomic profile
information of the participant, wherein the participant controls the privacy settings for the
participant, and the privacy settings for the participant can be configured by the
participant over the communications network (column 1, lines 36-44);

wherein the genomic profile information system is operable to indicate that the
participant is a member of a group (column 1 lines 65-67);

wherein the group is designated for members interested in avoiding or treating a
particular medical condition, the genomic information system is operable to provide
group members with access to genomic profile information, group functions, and
information, and the members comprise at least one of the participants for which
genomic profile information is stored (column 1 lines 50-53, column 1 lines 65-66); and

wherein the genomic profile information group functions comprise exchanging
information with other group members (column 1 lines 50-67).

With respect to claim 2, Holden discloses a system wherein the software system
enforces confidentiality for the genomic profile information of the participant unless
otherwise specified by the participant (column 5, lines 50-51).

Art Unit: 2131

With respect to claim 6, Holden discloses a system wherein the privacy settings comprise separate privacy settings for other participants and for researchers (column 1, lines 42-44).

With respect to claim 7, Holden discloses a system wherein the privacy settings comprise separate privacy settings indicating whether medical information of the participant can be accessed by others (column 1, lines 36-44).

With respect to claim 9, Holden discloses a system wherein the privacy settings comprise separate privacy settings indicating whether a primary disease of the participant can be accessed by others (column 3, lines 35-40, lines 53-58).

With respect to claims 10, 14, 15, and 16 Holden discloses a system wherein:

The settings indicate whether a participant's genomic profile information can be examined by other participants (column 2, lines 56-65); and

The software system accordingly allows examination of the participant's genomic profile information by other participants while preserving anonymity of the participant (column 3, lines 53-58; column 5, lines 50-51).

With respect to claim 17, Holden discloses a system wherein the settings indicate whether a participant's genomic profile information can be distributed (column 2, lines 60-65).

With respect to claim 18, Holden discloses a system wherein the settings indicate an organization to which a participant's genomic profile information can be distributed (column 2, lines 60-65).

With respect to claim 27, Holden discloses a genomic profile information system wherein the genomic profile information comprises genomic pathology information for one or more participants (column 4, lines 50-52: Pathology its the study of disease, and genomic pathology is a study of disease at the genomic level.).

With respect to claim 33, Holden discloses a method comprising:

Registering an individual as a participant in a genomic profile information center (column 1, lines 28-35);

Collecting personal genomic profile data of the participant (column 1, lines 28-35);

Adding the participant to a genomic profile information database (column 1, lines 28-35); and

Granting the participant custodial control over the participant's genomic profile information (column 2, lines 60-65);

indicating in the center that the participant is a member of a group (column 1 lines 65-67);

wherein the group is designated for members interested in avoiding or treating a particular medical condition, the genomic profile information center is operable to provide group members with access to genomic profile information functions and information, and the members comprise at least one of the participants for which genomic profile information is stored (column 1 lines 50-53, column 1 lines 65-66); and

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

With respect to claim 35, Holden discloses a method wherein custodial control comprises controlling, via a computer user interface, whether the participant's genomic profile information is to be provided to others (column 2, lines 56-65).

With respect to claim 36, Holden discloses a method wherein custodial control comprises controlling, via a computer user interface, whether the participant's genomic profile information is to be provided for use in a particular study (column 2, lines 56-65).

With respect to claim 37, Holden discloses a method wherein custodial control comprises controlling whether other participants being members of a designated group can access the participant's genomic profile information (column 2, lines 56-65).

With respect to claim 38, Holden discloses a method wherein the participant's genomic profile information is identified anonymously (column 5, lines 59-61).

With respect to claim 39, Holden discloses a method further comprising:

As a result of receiving authorization from the participant to provide the participant's genomic profile information for use in research, compensating the participant (column 2, lines 56-65).

With respect to claim 41, Holden discloses a method comprising:

Analyzing a biological sample collected from a patient to generate a genomic profile for the patient (column 1, lines 28-35);

Incorporating the genomic profile for the patient into a genomic profile information collection comprising genomic profile information for a plurality of other patients (column 1, lines 28-35); and

Compensating the patient by providing at least some level of access to the genomic profile information collection (column 2, lines 56-65);

indicating in the collection that the participant is a member of a group, wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 65-67);

providing group members with access to genomic profile information group functions and information, wherein the members comprise at least one patient for which genomic profile information is stored in the collection (column 1 lines 50-53, column 1 lines 65-66); and

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

With respect to claim 94, Holden discloses a genomic profile information center comprising:

Means for collecting personal genomic profiles from a plurality of participants (column 1, lines 28-35);

Means for pooling the personal genomic profiles into a collection of personal genomic profiles (column 1, lines 28-35); and

Means for recording compensation due to a participant as a result of having sold the collection to a requesting entity (column 2, lines 56-65);

wherein the genomic profile information center is operable to indicate that the participant is a member of a group (column 1 lines 65-67);

wherein the group is designated for members interested in avoiding or treating a particular medical condition, the genomic profile information center is operable to provide group members with access to genomic profile information group functions and information, and the members comprise at least one of the participants for which genomic profile information is stored (column 1 lines 50-53, column 1 lines 65-66); and

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

Art Unit: 2131

Claims 63 and 64 are rejected under 35 U.S.C. 1102(e) as being anticipated by Weschler, Jr. (U.S. Patent 6,757,720).

With respect to claim 63, Weschler, Jr. discloses a method comprising:

Storing a personal genomic profile for a participant in a database (column 4, lines 47-49);

Designating the participant as a member of a group (column 11, lines 60-66); and
Providing the participant with access to group functions and information (column 11, line 67 to column 12, line 1).

With respect to claim 64, Weschler, Jr. discloses a method wherein the group functions include exchanging information with other group members (column 9, lines 30-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2131

4. Claims 8, 11, 13, 21, 25, 28-32, 34, 40, 46, 56, 59, 60-62, 70,72, 87-88, and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Huff (U.S. Patent 6,670,731).

Holden and Huff are analogous art because both are in the field of electronic communication.

With respect to claim 8, Holden discloses the limitations set forth in claim 1, upon which claim 8 is dependent. Additionally, Holden discloses a genomic profile information system wherein: The privacy settings comprise separate privacy settings indicating whether group membership information of the participant in the system can be accessed by others (column 2, lines 56-65).

Holden does not disclose the system wherein: The software system indicates whether the participant is a member of one or more groups. Huff discloses the system wherein:

The software system indicates whether the participant is a member of one or more groups (column 12, lines 67: family is considered to be a distinct group.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Hoyden in order to make and store links between data items (column 4, lines 36-39).

Art Unit: 2131

With respect to claim 11, Holden discloses the limitations set forth in claim 10, upon which claim 11 is dependent.

Holden also discloses a genomic profile information system wherein:

The settings indicate whether a participant's genomic profile information can be examined by other participants who are members of the group (column 2, lines 56-65); and

The software system accordingly allows examination of the participant's genomic profile information while preserving anonymity of the participant (column 5, lines 59-61).

Holden does not disclose a system wherein:

The settings indicate one or more participants are members of a group. Huff discloses a system wherein:

The settings indicate one or more participants are members of a group (column 12, lines 67).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 13, Holden discloses the limitations set forth in claim 1, upon which claim 13 is dependent.

Holden does not disclose a genomic profile information system wherein:

The settings comprise an identifier by which a participant can be identified anonymously; and

The software system accordingly identifies the participant via the identifier. Huff discloses a genomic profile information system wherein:

the settings comprise an identifier by which a participant can be identified anonymously (column 17, lines 5-6, 49-56); and

the software system accordingly identifies the participant via the identifier (column 17, lines 5-6, 49-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to track royalties due and sequencing of the participants (column 17, lines 52-56).

With respect to claim 21, Holden discloses the limitations of claim 1, upon which claim 21 is dependent.

Holden does not disclose a genomic profile information system further comprising:

A comparison tool software system comprising comparison tools for comparing genomic profile information for two or more participants. Huff discloses a genomic profile information system of claim 1 further comprising:

Art Unit: 2131

A comparison tool software system comprising comparison tools for comparing genomic profile information for two or more participants (column 4, lines 5-7: In order to discover common ancestry, the two profiles must be compared.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to discover common linkage between persons in the database (column 4, lines 5-7).

With respect to claim 25, Holden discloses a genomic profile information system wherein the participants are listed anonymously (column 5, lines 59-61).

Holden does not disclose a system wherein comparison tools provide comparison results indicating one or more participants, and the participants are listed in the comparison results. Huff discloses a system wherein comparison tools provide comparison results indicating one or more participants, and the participants are listed in the comparison results (column 5, lines 3538).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

Art Unit: 2131

With respect to claims 28-32, Holden discloses the limitations set forth in claim 1, upon which claims 28-32 are dependent.

Holden does not disclose a system wherein the system has information for over 10,000, 100,000, 1,000,000, 10,000,000, or 100,000,000 participants. Huff discloses a system has information for over 10,000, 100,000, 1,000,000, 10,000,000, or 100,000,000 participants (column 4, lines 63-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to permit incorporation of existing large data collections (column 4, lines 15-18).

With respect to claim 34, Holden discloses the limitations set forth in claim 33, upon which claim 34 is dependent,

Holden does not disclose a computer-readable medium comprising computer-executable instructions for performing the method of claim 33. Huff discloses a computer-readable medium comprising computer-executable instructions for performing the method of claim 33 (column 4, lines 29-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to provide efficient access to the data (column 15, lines 19-21).

With respect to claim 40, Holden discloses the limitations set forth in claim 39, upon which claim 40 is dependent.

Holden does not disclose a method wherein compensation originates from payment by a third party. Huff discloses a method wherein compensation originates from payment by a third party (column 7, lines 59-61; column 8, lines 6-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claims 46 and 59, Holden discloses a method comprising:

Registering an individual as a participant in a genomic profile information network (column 1, lines 28-35);

Collecting genomic profile information from the participant, wherein the genomic profile information from the participant comprises gene expression information for one or more genes based on a biological sample taken from the participant (column 1, lines 28-35);

Adding the genomic profile information from the participant to a collection of data comprising genomic profile information from other participants, wherein the genomic profile information from the other participants comprises gene expression information for the one or more genes based on biological samples taken from the other participants (column 1, lines 2835); and

Presenting the genomic profile information of the one or more other participants, wherein identities of the one or more other participants remain anonymous (column 5, lines 59-61);

indicating in the collection that the participant is a member of a group, wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 65-67); and

providing group members with access to genomic profile information group functions and information, wherein the members comprise at least patient for which genomic profile information is stored in the collection (column 1 lines 50-53, column 1 lines 65-66); and

wherein the genomic profile information group functions comprise an exchanging information with other group members (column 1 lines 50-67).

Holden does not disclose a method comprising:

Comparing the genomic profile information of the participant with that from the other participants to generate comparison results indicating closeness between the

participant's genomic profile information and genomic profile information of one or more of the other participants. Huff discloses a method comprising:

Comparing the genomic profile information of the participant with that from the other participants to generate comparison results indicating closeness between the participant's genomic profile information and genomic profile information of one or more of the other participants (column 5, lines 35-38).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claims 55 and 56, Holden discloses a method comprising:

Directing a person to supply a biological sample from the person's body to a laboratory (column 1, lines 28-35);

Receiving an analysis of the biological sample from the laboratory and incorporating the analysis into a personal genomic profile for the person (column 1, lines 28-35);

Pooling the personal genomic profile with personal genomic profiles from other people into a collection of anonymous personal genomic profiles (column 5, lines 59-61); and

indicating in the collection that the person is a member of a group, wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 65-67);

Art Unit: 2131

providing group members with access to genomic profile information group functions and information, wherein the members comprise at least person for which genomic profile information is stored in the collection (column 1 lines 50-53, column 1 lines 65-66);

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

Holden does not disclose a method comprising:

Selling the collection of anonymous pooled personal genomic profiles to a requesting entity for payment; and

As a result of the sale, compensating the person via the payment. Huff discloses a method comprising:

Selling the collection of anonymous pooled personal genomic profiles to a requesting entity for payment (column 7, lines 59-61; column 8, lines 6-8); and As a result of the sale, compensating the person via the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

Art Unit: 2131

With respect to claim 60, Holden discloses a method wherein receiving personal genomic profile information of the participant comprises:

Receiving genotype information of the participant (column 4, lines 38-40); and
Receiving phenotype information of the participant (column 4, lines 43-46; column 5, lines 46-49).

With respect to claim 61, Holden does not disclose a method, further comprising:

Receiving payment for a collection of genomic profile information comprising the individual genomic profile information;

Wherein the monetary compensation is derived from the payment. Huff discloses a method, further comprising:

Receiving payment for a collection of genomic profile information comprising the individual genomic profile information (column 7, lines 59-61; column 8, lines 6-8);

Wherein the monetary compensation is derived from the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 62, Holden discloses a method, further comprising:

Art Unit: 2131

Combining the individual genomic profile information into a collection of genomic profile information comprising the individual genomic profile information (column 1, lines 2835).

Holden does not disclose a method, further comprising:

Selling the collection of genomic profile information comprising the individual genomic profile information in exchange for a payment;

Wherein the monetary compensation is derived from the payment.

Huff discloses a method, further comprising:

Selling the collection of genomic profile information comprising the individual genomic profile information in exchange for a payment (' ,column 7, lines 59-61; column 8, lines 6-8); Wherein the monetary compensation is derived from the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 70, Holden discloses a method for building a genomic profile information database, the method comprising:

Responsive to the request of an individual human being, adding a personal genomic profile for the individual human being to the database (column 1, lines 28-35); and

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing an anonymous version of the personal genomic profile from the database to the requestor (column 5, lines 59-61);

indicating in the database that the individual human being is a member of a group wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 50-67);

providing group members with access to genomic profile information group functions and information, wherein the members comprise at least one participant for which genomic profile information is stored in the database (column 1 lines 50-53, column 1 lines 65-66);

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

Holden does not disclose a method comprising:

Receiving a request to provide a collection of information comprising the personal genomic profile to a requestor in exchange for payment;

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing version of the personal genomic profile from the database to the requestor in exchange for payment; and

Based on having provided the anonymous personal genomic profile to the requestor, compensating the individual human being for having added the personal genomic profile via the payment. Huff discloses a method comprising:

Receiving a request to provide a collection of information comprising the personal genomic profile to a requestor in exchange for payment (column 7, lines 59-61; column 8, lines 6-8);

Responsive to the request to provide a collection of information comprising the personal genomic profile, providing the personal genomic profile from the database to the requestor in exchange for payment (column 7, lines 59-61; column 8, lines 6-8); and

Based on having provided the personal genomic profile to the requestor, compensating the individual human being for having added the personal genomic profile via the payment (column 7, lines 59-61; column 8, lines 6-8).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 72, Holden discloses a method for providing a service to a remote customer, the method comprising:

Obtaining a personal genomic profile of the customer (column 1, lines 28-35);

Pooling the profile with other profiles (column 5, lines 59-61);

indicating that the customer is a member of a group, wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 50-67);

providing group members with access to genomic profile information group functions and information, wherein the members comprise at least one participant for which genomic profile information is stored (column 1 lines 50-53, column 1 lines 65-66);

wherein the genomic profile information functions comprise exchanging information with other group members (column 1 lines 50-67).

Holden does not disclose a method comprising:

Over a computer network connection, providing the customer with tools to compare the profile with other profiles in the pool. Huff discloses a method comprising:

Over a computer network connection, providing the customer with tools to compare the profile with other profiles in the pool (column 4, lines 5-7).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 87, Holden discloses a computer-readable medium having computer-executable instructions for performing the following:

Receiving personal genomic profile information for an individual (column 1, lines 2835);

Adding the personal genomic profile information to a database (column 1, lines 28-35);

indicating in the database that the individual is a member of a group, wherein the group is designated for members interested in avoiding or treating a particular medical condition (column 1 lines 50-67);

providing group members with access to genomic profile information group functions and information wherein the members comprise at least one individual for which genomic profile information is stored in the database (column 1 lines 50-67);

wherein the genomic profile information group functions comprise exchanging information with other group members (column 1 lines 50-67).

Holden does not disclose a computer-readable medium having computer-executable instructions for performing the following:

Retrieving a pool of information from the database;

Receiving an indication that the pool of information has been sold; and

Responsive to receiving the indication, recording compensation data indicating the individual is to be compensated. Huff discloses a computer-readable medium having computer-executable instructions for performing the following:

Retrieving a pool of information from the database (column 5, lines 35-38);

Receiving an indication that the pool of information has been sold (column 17 lines 66-67 to column 18, lines 1-3); and

Responsive to receiving the indication, recording compensation data indicating the individual is to be compensated (column 18, lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to pay them the amount that they have earned (column 17, lines 55-56).

With respect to claim 88, Holden discloses a computer-readable medium wherein receiving the profile information comprises receiving the profile information over a computer network connection (column 2, lines 43-45).

With respect to claim 90, Holden discloses a computer-readable medium wherein the indication is received over a computer network connection (column 2, lines 43-45).

With respect to claim 91, Holden does not disclose a computer-readable medium wherein the pool of information from the database is a set of personal genomic profiles having specified criteria. Huff discloses a computer-readable medium wherein the pool of information from the database is a set of personal genomic profiles having specified criteria (column 5, lines 35-38).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

With respect to claim 92, Holden does not disclose a computer-readable medium further comprising computer-readable instructions for performing the following:

Receiving the specified criteria from a researcher; and
Presenting a number of individuals meeting the criteria to the researcher. Huff discloses a computer-readable medium further comprising computer-readable instructions for performing the following:

Receiving the specified criteria from a researcher (column 7, lines 59-61); and
Presenting a number of individuals meeting the criteria to the researcher (column 7, lines 59-61).

The motivational benefits of combining the teachings of Huff with the teachings of Holden are stated above.

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Bisbee et al. (U.S. Patent 6,237,096).

Holden and Bisbee et al. are analogous art because both are in the field of electronic communication.

With respect to claim 5, Holden discloses the limitations set forth in claim 1, upon which claim 5 is dependent.

Holden does not disclose a genomic profile information system wherein identity of the participant is authenticated over the communications network via biometric screening. Bisbee et al. disclose a genomic profile information system wherein identity of the participant is authenticated over the communications network via biometric screening (column 5, lines 25-28).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Bisbee et al. with the teachings of Holden in order to provide nonrepudiation of the applicant's authentication, as is well known in the art.

6. Claims 3, 4, and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Weschler, Jr. (U.S. Patent 6,757,720).

Holden and Weschler, Jr. are analogous art because both are in the field of electronic communication. With respect to claim 3, Holden discloses the genomic profile information system of claim 1.

Holden does not disclose the system wherein:

The settings indicate a computer system under a participant's control on which at least some of the participant's genomic profile information resides; and

The software system accordingly directs requests for information residing on the computer system under the participant's control to the computer system under the participant's control.

Weschler, Jr. discloses the system wherein:

The settings indicate a computer system under a participant's control on which at least some of the participant's genomic profile information resides (column 1, lines 50-56); and

The software system accordingly directs requests for information residing on the computer system under the participant's control to the computer system under the participant's control (column 1, lines 38-41).

It would have been obvious to one of ordinary skill in the art to have combined the teachings of Weschler, Jr. with the teachings of Holden in order to provide an easier

Art Unit: 2131

implementation of user-by-user storage location direction and extensibility to access, retrieve, and use profile information for a new user (column 2, lines 19-24).

With respect to claim 4, Holden discloses the genomic profile information system of claim 1.

Holden does not disclose the system wherein at least some of the participant's genomic profile information residing on a computer system under the participant's control is provided to another participant via a peer-to-peer network arrangement. Weschler, Jr. discloses the system wherein at least some of the participant's genomic profile information residing on a computer system under the participant's control is provided to another participant via a peer-to-peer network arrangement (column 6, lines 38-40).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 42, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein the genomic profile information collection comprises a network of computers communicating via a peer-to-peer network arrangement. Weschler, Jr. discloses the system wherein the genomic profile

Art Unit: 2131

information collection comprises a network of computers communicating via a peer-to-peer network arrangement (column 6, lines

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 43, Holden discloses the genomic profile information system of claim 41.

Holden does not disclose the system wherein incorporating comprises storing a reference to a computer under control of the patient at which genomic profile information for the patient can be accessed. Weschler, Jr. discloses the system wherein incorporating comprises storing a reference to a computer under control of the patient at which genomic profile information for the patient can be accessed (column 1, lines 50-52).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 44, Holden discloses the genomic profile information system of claim 41.

Art Unit: 2131

Holden does not disclose the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and accessed by others by accessing the computer system under control of the patient. Weschler, Jr. discloses the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and accessed by others by accessing the computer system under control of the patient (column 1, lines 50-56).

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

With respect to claim 45, Holden discloses the genomic profile information system of claim 41. .

Holden does not disclose the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and access to the genomic profile for the individual is provided by the computer system under control of the patient.

Weschler, Jr. discloses the system wherein the genomic profile for the patient is stored on a computer system under control of the patient and access to the genomic profile for the individual is provided by the computer system under control of the patient (column 1, lines 50-56).

Art Unit: 2131

The motivational benefits of combining the teachings of Weschler, Jr. and Holden are stated above.

7. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Eberhardt (U.S. Patent 5,659,741).

Holden, Huff and Eberhardt are all analogous art because all are in the field of electronic communication.

With respect to claim 19, Holden discloses the limitations set forth in claim 1, upon which claim 19 is dependent.

Holden does not disclose a genomic profile information system wherein a set of participants have a disease condition, and the genomic profile information comprises information indicating the outcomes of therapies for the disease condition (column 3, lines 63-67; column 4, lines 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have, combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to decrease the need for expensive diagnostic tests (column 3, lines 1-3).

With respect to claim 20, Holden discloses the limitations set forth in claim 1, upon which claim. 20 is dependent.

Holden does not disclose a genomic profile information system wherein the genomic profile information system further comprises comparison tools operable by a researching participant having a disease condition, and the tools identify therapy outcomes for participants having a disease condition and molecular portrait similar to the researching participant (column 3, lines 63-67; column 4, lines 30-34).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

8. Claims 22, 24, 65-67, and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) and Huff (U.S. Patent 6,760,731) in view of Eberhardt (U.S. Patent 5,659,741).

With respect to claim 22, Holden and Huff disclose the limitations set forth in claim 21, upon which claim 22 is dependent. Holden discloses patient-driven analyses of genomic profile information (column 4, lines 32-33).

Holden does not disclose a genomic profile information system wherein the participant is a patient having a disease condition, and the comparison tools support comparative

Art Unit: 2131

analyses of genomic profile information over a communications network. Eberhardt discloses a system wherein the participant is a patient having a disease condition, and the comparison tools support comparative analyses of genomic profile information over a communications network (column 3, lines 63-ti7; column 4, lines 30-34).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to decrease the need for expensive diagnostic tests (column 3, lines 1-3).

With respect to claim 24, Holden and Huff disclose the limitations set forth in claim 21, upon which claim 24 is dependent.

Holden does not disclose a genomic profile information system wherein at least one of the tools compares drug response information. Eberhardt discloses a system wherein at least one of the tools compares drug response information (column 3, lines 63-67; column 4., lines 30-34).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

Art Unit: 2131

With respect to claim 65, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those interested in acquiring information about a particular medical condition. Eberhardt discloses a method further comprising:

Limiting members of the group to those: interested in acquiring information about a particular medical condition (column 8, lines 39-41).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Eberhardt with the combined teachings of Holden and Huff in order to

With respect to claim 66, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those having a particular medical condition. Eberhardt discloses a method further comprising:

Limiting members of the group to those having a particular medical condition (column 8, lines 30-34).

Art Unit: 2131

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

With respect to claim 67, Holden and Huff disclose the limitations set forth in claim 63.

Holden and Huff do not disclose a method further comprising:

Limiting members of the group to those having substantially similar age, sex, or race.

Eberhardt discloses a method further comprising:

Limiting members of the group to those having similar age, sex, or race (column 16, lines 15-18).

The motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

With respect to claim 89, Holden and Huff disclose the limitations set forth in claim 88, upon which claim 89 is dependent.

Holden does not disclose a genomic profile information system wherein receiving the profile information comprises receiving the profile information from a remote laboratory.

Eberhardt discloses a system wherein receiving the profile information comprises receiving the profile information from a remote laboratory (column 10, line 50). The

Art Unit: 2131

motivational benefit of combining the teachings of Eberhardt with those of Holden and Huff are stated above.

9. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U. S. Patent 6,640,211) and Huff (U.S. Patent 6,670,731) in view of Adams (U.S. Patent 5,966,711).

Holden, Huff and Adams are analogous art because both are in the field of electronic communication.

With respect to claim 23, Holden and Huff disclose the limitations of claim 21.

Holden and Huff do not disclose a genomic profile information system wherein at least one of the tools compares gene expression. Adams discloses a genomic profile information system wherein at least one of the tools compares gene expression (column 5, lines 28-33; column 6, lines 9-10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Adams with the teachings of Holden and Huff in order to simplify maintaining database heterogeneity and process synchronization (column 5, lines 25-27).

10. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) in view of Huff (U.S. Patent 6,670,731) and further in view of Shapiro et al. (U.S. Patent 6,714,944).

Holden, Huff and Shapiro et al, are analogous art because both are in the field of electronic communication.

With respect to claim 12, Holden discloses the genomic profile information system of claim 1. Additionally, Holden discloses the ability maintain anonymity of the participant (column 5, lines 59-61).

Holden does not disclose a system further comprising: .

Software for identifying two or more participants having similar genomic profile information; wherein the identifying software presents a user interface option to a participant for contacting another similar participant. Huff discloses a system further comprising:

Software for identifying two or more participants having similar genomic profile information (column 5, lines 58-60).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Huff with the teachings of Holden in order to discover common linkage between persons in the database (column 4, lines 5-7).

Huff does not disclose a system further comprising:

Wherein the identifying software presents a user interface option to a participant for contacting another similar participant. Shapiro et al. disclose a system further comprising:

Wherein the identifying software presents a user interface option to a participant for contacting another similar participant (column 8, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8, lines 51-53).

11. Claims 26 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holden (U.S. Patent 6,640,211) and Huff (U.S. Patent 6,670,731) in view of Shapiro et al. (U.S. Patent 6,714,944).

Holden, Huff and Shapiro et al. are analogous art because both are in the field of electronic communication.

With respect to claim 26, Holden and Huff disclose a genomic profile information system of claim 25. Additionally, Holden discloses anonymous listings of the participant (column 5, lines 59-61).

Holden and Huff do not disclose a system wherein at least one of the participants can be selected by a computer user interface to send a message to the participant. Shapiro et al. disclose a system wherein at least one of the participants can be selected by a computer user interface to send a message to the participant (column 8, lines 58-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8, lines 51-53).

With respect to claim 47, Holden and Huff disclose the limitations set forth in claim 46.

Holden and Huff do not disclose a method further comprising:

Accepting a selection via a graphical user interface from the participant indicating a message is to be sent to the one or more other participants; and

Responsive to the selection, sending a message to the one or more other participants.

Shapiro et al. disclose a method further comprising:

Accepting a selection via a graphical user interface from the participant indicating a message is to be sent to the one or more other participants (column 8, lines 63-67 to column 9, lines 1-6); and

Responsive to the selection, sending a message to the one or more other participants (column 9, lines 20-21).

It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the teachings of Shapiro et al. with the combined teachings of Holden and Huff in order to distribute documents to various third parties (column 8 lines 51-55).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaveh Abrishamkar whose telephone number is 571-272-3786. The examiner can normally be reached on Monday thru Friday 8-5.

Art Unit: 2131

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KA
09/28/2005


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